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| EXAMINER |
|---|
| DEBROW, JAMES J |

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| 2176 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/507,341 | UNDASAN, RENALDO VALENCIO |
| | **Examiner** | **Art Unit** | |
| | James J. Debrow | 2176 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on <u>05 September 2007</u>.

2a) ☐ This action is **FINAL**.    2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) <u>1-23</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-23</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION

1.      This action is responsive to communications: Amendment filed 05 Sep. 2007.

2.      Claims 1-21 are pending in this case. Claims 1, 10 and 18 are independent

claims.

### *Applicant's Response*

3.      In Applicant's Response dated 05 Sep. 2007, Applicant amended claims 1, 5, 6,

10 and 16; added new claim 18-21.  Applicant argued against all rejections previously

set forth in the Office Action dated 08 Sep. 2006.

### *Response to Amendment*

4.      The affidavit filed on 05 Sep. 2007 under 37 CFR 1.131 has been considered but

is <u>ineffective to overcome the Petropoulos reference at this time</u>.

5.      The evidence submitted is insufficient to establish diligence from a date prior to

the date of reduction to practice of the Petropoulos reference (September 24, 2001) to

either a constructive reduction to practice or an actual reduction to practice (March 15,

2002).

The Examiner accepts Applicant's "Exhibit 2" and "Exhibit 3" as evidence of "time

of conception" prior to the effective date of the Petropoulos reference. However,

Examiner concludes the Applicant has not proven reasonable diligence from just prior to

the reference date to a constructive reduction in practice.

It is noted that the only exhibit of evidence that falls between the above date range above is Exhibit 8. This is insufficient to establish diligence, as will be explained below.

In reference to MPEP 2138.06 "Reasonable Diligence", the period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. Rebstock v. Flouret, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); Rieser v. Williams, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field); Griffith v. Kanamaru, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable excuses.); Litchfield v. Eigen, 535 F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for testing not sufficiently described); Morway v. Bondi, 203 F.2d 741, 749, 97 USPQ 318, 323 (CCPA 1953) **(voluntarily laying aside inventive concept in pursuit of other projects is generally not an acceptable excuse although there may be circumstances creating exceptions)**; Anderson v. Crowther, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) **(preparation of routine periodic reports covering all accomplishments of the laboratory insufficient to show diligence)**; Wu v. Jucker, 167 USPQ 467, 472-73 (Bd. Pat. Inter. 1968) (applicant improperly allowed test data

sheets to accumulate to a sufficient amount to justify interfering with equipment then in use on another project);

In re Jolley, 308 F.3d 1317, 1326-27, 64 USPQ2d 1901, 1908-09 (Fed. Cir. 2002) (diligence found based on research and procurement activities related to the subject matter of the interference count).< "[U]nder some circumstances an inventor should also be able to rely on work on closely related inventions as support for diligence toward the reduction to practice on an invention in issue." Ginos v. Nedelec, 220 USPQ 831, 836 (Bd. Pat. Inter. 1983) **(work on other closely related compounds that were considered to be part of the same invention and which were included as part of a grandparent application).** "The work relied upon must be directed to attaining a reduction to practice of the subject matter of the counts. **It is not sufficient that the activity relied on concerns related subject matter."**


The Examiner does not interpret Exhibit 5 (Search Results) and Exhibit 6 as evidence of working on closely related inventions as support for diligence. A search report displaying "possible related patents" and one's opinion (Exhibit 6) concerning the relevance of those "possible related patents" does in no way constitute "work" on closely related invention.


In regards to Exhibit 7 and Exhibit 8, the Examiner does not see the relevance of these exhibits and the content therein. Exhibits 7 and 8 purport to show two emails asking that the case be assigned to (priority) AC=1, from previously set AC=2. Setting a

priority is insufficient evidence showing development of the actual invention. At best,

this merely shows Applicant's intention to place more attention to the invention.

Although Paul Hillier is shown as a patent engineer, it is unclear who Elspeth and David

are. It is also noted that both exhibits 7 and 8 do not appear to originate from (nor sent

to) the inventor(s).

6.    Furthermore even if the Examiner were to accept Applicant declaration of prior

invention, which the Examiner does not, the proposed affidavit filed on 05 Sep. 2007

would not be entered because it is unsigned by the inventor(s).

## *Claim Rejections - 35 USC § 102*

7.    The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8.    **Claims 1-6 and 10-23 are rejected under 35 U.S.C. 102(e) as being**

**anticipated by Petropoulos et al. (Patent No.: US 7,047,502 B2; Filing Date:**

**September 24, 2001) (hereinafter "Petropulos").**

**In regards to independent claim 1,** Petropoulos disclose *a method for*

*previewing documents on a computer system comprising the steps of:*

*displaying a main document which contains a first hyperlink* (col. 3, lines 32-51;

Petropulos discloses a search-result page/document containing a first hyperlink.).

*in response to an indication of the first hyperlink being received by the computer*

*system, displaying a first preview document which document being that referred to by*

*the first hyperlink whilst retaining a display of the main document, so that the document*

*referred to by the first hyperlink may be previewed* (col. 3, line 63 – col. 4, line 44;

Petropulos discloses showing preview information when the mouse pointer navigates or

passes (mouse-over) over a defined area. The define area includes but is not limited to

hyperlinks.).

*wherein the first hyperlink is indicated to the computer system by positioning a*

*pointer over the hyperlink* (col. 3, line 63 – col. 4, line 44; Petropulos discloses showing

preview information when the mouse pointer navigates or passes (mouse-over) over a

defined area. The define area includes but is not limited to hyperlinks. Thus Petropulos

discloses the first hyperlink is indicated to the computer system by positioning a pointer

over the hyperlink.).

**In regards to dependent claim 2,** Petropoulos disclose *a method according to*

*claim 1 wherein the first preview document contains a second hyperlink, further*

*comprising the step of:*

*in response to an indication of the second hyperlink being received by the computer system, displaying a second preview document which document being that referred to by the second hyperlink whilst retaining the display of the first preview document so that the document referred to by the second hyperlink may be previewed* (col. 5, lines 3-26; Petropulos discloses the first preview window may disclose a list of similar sites or pages and then each item in the list is mouse-over, a preview of the reference site or page may be displayed.).

**In regards to dependent claim 3,** Petropoulos disclose *a method according to claim 1 or 2 further comprising the step of:*

*in response to an indication of a displayed document being received by the computer system, removing from display any and all preview documents deriving from the indicated document* (col. 7, lines 1-9; Petropulos discloses the preview information may be displayed in a frame open promximate to the time of the mouse-over and endures approximately until the mouse-over ends.).

**In regards to dependent claim 4,** Petropoulos disclose *a method according to claim 1 or 2 further comprising the steps of:*

*in response to a selection of a displayed preview document being received by the computer system, substituting the selected preview document for the main document* (col. 7, lines 26-30; col. 9, lines 40-46; Petropulos discloses the user selecting/displaying a web page by clicking through on the preview or link.).

*removing from display all preview documents* (col. 7, lines 1-9; Petropulos

discloses the preview information may be displayed in a frame open promximate to the

time of the mouse-over and endures approximately until the mouse-over ends.).

**In regards to dependent claim 5,** Petropulos discloses *a method according to*

*claim 3 further comprising the step of:*

*caching a preview document which has been removed from display* (col. 11, lines

29-42; Petropulos discloses the concept of caching preview documents.).

**In regards to dependent claim 6,** Petropulos discloses *a method according to*

*claim 2 wherein the second hyperlink is indicated to the computer system by*

*positioning a pointer over the hyperlink.* (col. 5, lines 3-26; Petropulos discloses the first

preview window may disclose a list of similar sites or pages and then each item in the

list is mouse-over, a preview of the reference site or page may be displayed.).

**In regards to independent claim 10,** Petropoulos disclose *a system for*

*displaying a preview document referred to by a hyperlink in a main document, the*

*system comprising a workstation, a first document store containing a first preview*

*document and an interconnection means* (col. 10, line 48 – col. 11, line 11; Petropulos

discloses a computer network comprising of interconnections between

computers/*workstation* and servers/*document store.*).

*the workstation being operable to co-operate with the first document store using*

*the interconnection means to access the first preview document and, in response to an*

*indication of the hyperlink being received by the workstation, to display the first preview*

*document in addition to displaying the main document* (col. 3, line 63 – col. 4, line 44;

Petropulos discloses showing preview information when the mouse pointer navigates or

passes (mouse-over) over a defined area. The define area includes but is not limited to

hyperlinks.).

*wherein the hyperlink is indicated to the workstation by positioning a pointer over*

*the hyperlink* (col. 3, line 63 – col. 4, line 44; Petropulos discloses showing preview

information when the mouse pointer navigates or passes (mouse-over) over a defined

area. The define area includes but is not limited to hyperlinks. Thus Petropulos

discloses the first hyperlink is indicated to the computer system by positioning a pointer

over the hyperlink.).


**In regards to dependent claim 11,** Petropulos discloses *a system as claimed in*

*claim 10, further comprising a server coupled to a second document store containing a*

*second preview document, the server operable to co-operate with the workstation using*

*the interconnection means, to access the second preview document in the second*

*document store and to download the second preview document to the workstation* (col.

10, line 48 – col. 11, line 11; col. 5, lines 3-26; Petropulos discloses a computer network

comprising of interconnections between computers/*workstation* and servers/*document*

*store*. Petropulos also discloses the first preview window may disclose a list of similar

sites or pages and then each item in the list is mouse-over, a preview of the reference

site or page may be displayed.).

**In regards to dependent claim 12,** Petropulos discloses *a workstation*

*comprising a display, data processing unit and user interface, operable according to the*

*method of claims 1-9 to display preview documents* (col. 10, line 48 – col. 11, line 11;

col. 5, lines 3-26; Petropulos discloses a computer network comprising of

interconnections between computers/*workstation* and servers/*document store.*

Petropulos also discloses the first preview window may disclose a list of similar sites or

pages and then each item in the list is mouse-over, a preview of the reference site or

page may be displayed.).

**In regards to dependent claim 13,** Petropulos discloses *a workstation as*

*claimed in claim 12, further comprising a local document store, the workstation being*

*operable to access a preview document from said document store* (col. 11, lines 27-36;

Petropulos discloses retrieving a preview document from a cache maintained near a

data store. Thus Petropulos discloses preview information can be accessed local to the

database.).

**In regards to dependent claim 14,** Petropulos discloses *a workstation as*

*claimed in claim 12, further comprising a data store operable to cache the content and*

*data associated with a preview document which has been removed from display* (col.

11, lines 27-42; Petropulos discloses retrieving a preview document from a cache maintained near a data store. Thu, Petropulos discloses the concept of caching preview documents.).

**In regards to dependent claim 15,** Petropulos discloses *a Web browser application running on a computer system and displaying a main document, the application configured to be operable according to the method of claims 1-9 to display preview documents whilst also displaying the main document* (col. 3, lines 32-51; col. 3, line 63 – col. 4, line 44; col. 5, lines 3-26; Petropulos discloses a search-result page/document containing a first hyperlink. Petropulos also discloses showing preview information when the mouse pointer navigates or passes (mouse-over) over a defined area. The define area includes but is not limited to hyperlinks. Petropulos further disclose the first preview window may disclose a list of similar sites or pages and then each item in the list is mouse-over, a preview of the reference site or page may be displayed.).

**In regards to dependent claim 16,** Petropulos discloses *a Web browser application as claimed in claim 15 wherein the main document is controllable using at least one tool provided by the application* (col. 3, lines 32-51; col. 10, line 48 – col. 11, line 11; Petropulos discloses displaying a search-result page/document containing a first hyperlink in a web browser.).

**In regards to dependent claim 17,** Petropulos discloses *a method according to claim 4 further comprising the step of: caching a preview document which has been removed from display* (col. 11, lines 29-42; Petropulos discloses the concept of caching preview documents.).

**In regards to independent claim 18,** Petropoulos disclose *a method of browsing internet websites comprising:*

*(a) in response to placing a pointer over a URL reference or symbol of a current web page, displaying a first pop-up preview-window also having a URL reference or symbol* (col. 3, line 63 – col. 4, line 44; Petropulos discloses showing preview information when the mouse pointer navigates or passes (mouse-over) over a defined area. The define area includes but is not limited to hyperlinks.).

*(b) in response to placing the pointer over the URL reference or symbol of the pop-up preview-window, displaying a child pop-up preview-window* (col. 5, lines 3-26; Petropulos discloses the first preview window may disclose a list of similar sites or pages and then each item in the list is mouse-over, a preview of the reference site or page may be displayed.).

**In regards to dependent claim 19,** Petropulos discloses *the method according to claim 18, further including repeating step (b) to generate a plurality of child preview windows* (col. 5, lines 3-26; Petropulos discloses the first preview window may disclose

a list of similar sites or pages and then each item in the list is mouse-over, a preview of

the reference site or page may be displayed.).

**In regards to dependent claim 20,** Petropulos discloses *the method according*

*to claim 18, further including displaying one of the preview windows as a current page in*

*response to clicking on the specific preview window and removing all other preview*

*windows from the display* (col. 7, lines 1-9; col. 7, lines 26-30; col. 9, lines 40-46;

Petropulos discloses the preview information may be displayed in a frame open

promximate to the time of the mouse-over and endures approximately until the mouse-

over ends. Petropulos discloses the user selecting/displaying a web page by clicking

through on the preview or link.).

**In regards to dependent claim 21,** Petropulos discloses *the method according*

*to claim 19, wherein when a new preview window is displayed, the pointer is*

*automatically repositioned within the new preview window* (col. 7, lines 1-9; Petropulos

discloses the preview information may be displayed in a frame open promximate to the

time of the mouse-over and endures approximately until the mouse-over ends. Thus in

order to display the new preview window, the pointer is automatically repositioned within

the new preview window.).

**In regards to dependent claim 22** Petropulos discloses *the method according*

*to claim 21, further including in response to moving the pointer out of the new preview*

*window back to a previous preview window, removing the new preview window* (col. 7,

lines 1-9; Petropulos discloses the preview information may be displayed in a frame

open promximate to the time of the mouse-over and endures approximately until the

mouse-over ends.).

**In regards to dependent claim 23,** Petropulos discloses *the method according*

*to claim 21, further including in response to moving the pointer out of the new preview*

*window a previous preview window, removing all preview windows that are subsequent*

*to the previous preview window* (col. 7, lines 1-9; Petropulos discloses the preview

information may be displayed in a frame open promximate to the time of the mouse-

over and endures approximately until the mouse-over ends.).

9.     It is noted that any citations to specific, pages, columns, lines, or figures in the

prior art references and any interpretation of the reference should not be considered to

be limiting in any way. A reference is relevant for all it contains and may be relied upon

for all that it would have reasonably suggested to one having ordinary skill in the art.

See MPEP 2123.

### *Claim Rejections - 35 USC § 103*

10.     The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

**11.     Claims 7-9, and are rejected under 35 U.S.C. 103(a) as being unpatentable**

**over Cragun and Petropoulos, in view of Hunt et al. (Pub. No.: US 2004/0133848**

**A1; Pub. Date: Apr. 26, 2000 (provisional)) (hereinafter 'Hunt').**

**In regards to dependent claim 7,** Petropoulos does not expressly disclose *a*

*method according to claim 3 wherein the document is indicated by positioning a pointer*

*at a location in the displayed document where there is not a hyperlink.*

However, Hunt teaches *a method according to claim 3 wherein the document is*

*indicated by positioning a pointer at a location in the displayed document where there*

*is not a hyperlink* (0346; Hunt teaches displays popup windows as separate views

stacked on top of each other, exposing only the tab can be used to select the current

one. When the tab is selected, the view of the window will be brought to the front.).

Therefore, at the time of the invention it would have been obvious to a person of

ordinary skill in the art to combine Petropoulos with Hunt for the benefit of enabling

quick access to the desired portion of the information content (0028).

**In regards to dependent claim 8,** Petropoulos does not expressly disclose *a method according to claim 4 wherein the preview document is selected by clicking a pointer at a location in the displayed preview document where there is not a hyperlink.*

However, Hunt teaches *a method according to claim 4 wherein the preview document is selected by clicking a pointer at a location in the displayed preview document where there is not a hyperlink* (0346; Hunt teaches displays popup windows as separate views stacked on top of each other, exposing only the tab can be used to select the current one. When the tab is selected, the view of the window will be brought to the front.).

Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Petropoulos with Hunt for the benefit of enabling quick access to the desired portion of the information content (0028).


**In regards to dependent claim 9,** Petropoulos does not expressly disclose *a method according to any preceding claim wherein documents are displayed in windows according to Microsoft Windows format.*

However, Hunt teaches *a method according to any preceding claim wherein documents are displayed in windows according to Microsoft Windows format* (0292; 0332).

Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Petropoulos with Hunt for the benefit of enabling quick access to the desired portion of the information content (0028).

12.    It is noted that any citations to specific, pages, columns, lines, or figures in the

prior art references and any interpretation of the reference should not be considered to

be limiting in any way. A reference is relevant for all it contains and may be relied upon

for all that it would have reasonably suggested to one having ordinary skill in the art.

See, MPEP 2123.

### *Response to Arguments*

13.    Applicant's arguments filed 05 Sep. 2007 have been fully considered but they are

not persuasive.

Applicant argues *a Declaration by the inventor with appropriate supporting*

*evidence showing conception of the presently claimed invention prior to the filing date of*

*at least one of the applied references. As set forth in MPEP 715, swearing behind any*

*one reference eliminates that ground of rejection.*

The Examiner disagrees as described above in section 4, Response to

Amendment.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to James J. Debrow whose telephone number is 571-272-

5768. The examiner can normally be reached on 8:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).


JAMES DEBROW
EXAMINER
ART UNIT 2176


**WILLIAM BASHORE**
**PRIMARY EXAMINER**